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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/707,019
Filing Date: November 14, 2003
Appellant(s): HUNT ET AL.

Lisa J. Serdynski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/14/2009 appealing from the Office action mailed 02/27/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6767024	Kuo	7-2004
6382370	Girvin	5-2002

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16-21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuo US 6,767,024.

Kuo discloses:

- a body (30) attachable to a handlebar (C) of the handlebar-steered vehicle;
- an actuator assembly (22, B) including a lever arm (see arm portion of 22) in pivoting engagement with the body (30) about a pivot axis,
- the lever arm associated with a suspension adjust cable (B),
- the actuator assembly having a first position corresponding to a first suspension setting (C3/L25-50, the position of the actuator shown in figure 4B) and a second position (C3/L25-50, the position shown in figure 4) corresponding to a second suspension setting;
- an actuator control assembly (20, 21) including an adjustment assembly (21, 20) associated with each of the body (30) and the actuator assembly,
- the adjustment assembly (20, 21) configured to position the actuator assembly relative to the body in the second position (position shown in 4 or 4a) corresponding to the second position and corresponding second suspension setting are adjustable within a range (range of positions shown between figure 4 and 4a, also see arrow in figure 4a showing range of positions) of alternative second suspension positions and corresponding second suspension settings through the adjustment assembly independently of the first suspension setting (lockout position

shown in figure 4b does not affect positions shown in figures 4 and 4a and is therefore “independent” as claimed)

- wherein the actuator control assembly further includes a locking assembly (231, 13)
- wherein the locking assembly includes a push-button (231) associated with the body,
- wherein the locking assembly further comprises: a locking guide surface (see surface of 231) having a locking region (see region occupied by follower pin 13 in figure 4B); and a locking follower assembly (13, 231, 212) including the push-button (231) with a follower pin (13) disposed thereon,
- wherein the locking follower assembly further comprises a biasing member (see 212 in figure 4, or 23) associated with the push-button,
- wherein the first suspension setting is substantially rigid (C3/L25-50, the position of the actuator shown in figure 4B)
- wherein the adjustment assembly comprises an adjustment guide surface (21, or 212) and a translationally adjustable mating pin (12, or 13) configured to engage the adjustment guide surface.
- Wherein the pivot axis of the lever arm (22) is substantially parallel to an axis of the handlebar (C).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 11-15 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo US 6,767,024 in view of Girvin US 6,382,370.

Kuo discloses:

- a body (30) attachable to a handlebar (C) of the handlebar-steered vehicle (see bicycle in figure 2);
- an actuator assembly (21, 22) including a lever arm (see arm portion of 22) in pivoting engagement with the body about a pivot axis,
- the lever arm associated with a suspension adjust cable (B) ;
- an actuator control assembly (13, 231, 212, 20, 111, 113, 11), the actuator control assembly including:
 - a locking assembly (13, 231, 212) associated with each of the body and the actuator assembly,
 - an adjustment assembly (20, 111, 113, 11) associated with each of the body and the actuator assembly,
 - the adjustment assembly (20, 21) configured to position the actuator assembly relative to the body in the second position (position shown in 4 or 4a) corresponding to the second position and corresponding second

suspension setting are adjustable within a range (range of positions shown between figure 4 and 4a, also see arrow in figure 4a showing range of positions) of alternative second suspension positions and corresponding second suspension settings through the adjustment assembly independently of the first suspension setting (lockout position shown in figure 4b does not affect positions shown in figures 4 and 4a and is therefore “independent” as claimed)

- wherein the first suspension setting is substantially rigid (C3/L25-50, first suspension setting corresponds to the lockout position shown also in figure 4B).
- wherein the pivot axis of the lever arm is substantially parallel with an axis of the handlebar (see figure 1, pivot axis of the lever arm is shown parallel with axis of handlebar)
- wherein the lever arm further includes: a cable securing assembly (see figures 4-4B, cable B is secured into lever 22); and an actuation tab (actuation tab is upper portion of 22).
- wherein a cable moment arm created by the cable securing assembly and the pivot axis is smaller than an actuation moment arm created by the actuation tab and the pivot axis (see figures 4-4B, cable securing assembly is shown radially inward of actuation tab, thus resulting in a smaller moment arm).

- wherein the body further comprises an attachment assembly (30) is concentrically mounted around handlebar C) including a ring clamp capable of substantially concentric position about the handlebar.

Kuo discloses a suspension adjust cable actuator with a pivot axis. Kuo does not disclose a pivot axis spaced apart from an axis of the handlebar. Girvin teaches an actuator (15) with a pivot axis spaced apart from (see figure 1) an axis of the handlebar (13). Because both Kuo and Girvin teach suspension adjust cable actuators, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute a pivot axis spaced apart from an axis of the handlebar for a coaxial pivot axis to achieve the predictable result of actuating a suspension adjust cable.

(10) Response to Argument

Appellant argues “Claims 16-21 and 23 were rejected under 35 U.S.C. 102(e) as being anticipated by Kuo (US Patent No. 6,767,024). Examiner mischaracterizes the structure and function of Kuo, giving it adjustment capabilities that it does not have, nor can have, without re-engineering. Examiner describes an adjustment range of Kuo corresponding to approximately 90 degrees between reference character 11 and stop device 13 in FIG. 4, when in fact, Kuo can only be positioned at the end points, at reference character 11 or at stop device 13, and not at any point therebetween. Indeed, lever 22 is either held in the locked position (spring 231 wedged against stop device 13), or upon release of the spring 231, the lever 22 is automatically rotated back to its operative position (near reference character 11) by the tensioned control cable B, in turn biased by the torsion spring 612 connected to the cap 61. In other words, cap 61 is

connected to lever 22 by control cable B. One cannot move without affecting the other. Pushing lever 22 into its locked position (shown in FIG. 4B), necessarily rotates cap 21, working against biased spring 612. Upon releasing lever 22 from its locked position, the biasing spring 612 rotates the cap 61, and necessarily, lever 22 back to its operative position. Contrary to Examiner's assertion, there are no intermediate lever 22 positions. FIG. 4A merely shows lever 22 in motion, just before reaching its locked position of FIG. 4B. Indeed, if there were a range of intermediate lever 22 positions, as Examiner suggests, why would locking spring plate 231 be provided? Precisely because the lever 22 cannot be positioned within a range of alternative second suspension settings. Kuo is entirely missing an "adjustment assembly configured to position the actuator assembly relative to the body in the second position" as claimed in the present invention. Kuo only permits lever 22 to be positioned in a single locked position or alternatively a single operative position. For this reason, the 102 rejection should be withdrawn."

In response, the device of Kuo is capable of being adjusted within a range of alternative second suspension settings independent of the first suspension setting. For example, see figures 4, 4a, and 4b. The adjustment range corresponds to an angular range of approximately 90 degrees shown between reference character 11 and stop device 13. In another example it can be seen that the position shown in figure 4a is clearly between the either of the positions shown in figure 4 and figure 4b. Further, it is clear from figures 4, 4a and 4b, that Kuo is capable of being operated through an infinite number of adjustment positions.

Applicant asserts that "...the lever 22 is automatically rotated back to its operative position (near reference character 11) by the tensioned control cable B, in turn biased by the torsion spring 612 connected to the cap 61...", however this assertion lacks merit and is in fact a mischaracterization of the reference, as Kuo clearly discloses that "**When rotating** the lever 22 in opposite direction and back to its operative position, the cap 61 is rotated by the torsion spring 612 automatically" (C3/L40-43). That is to say, it is not the lever 22 which is rotated automatically by spring 612, but rather, the cap 61, and this only occurs "**when rotating** the lever 22". Therefore it can be seen that lever 22 **does not** automatically rotate, as asserted by applicant. As such, the device of Kuo is clearly capable of being positioned within a range of alternative second suspension settings, for example, corresponding to any lever position between reference character 11 and 13, or, for example, in the position shown in figure 4a.

Additionally, the claim language "configured to" followed by functional language within the apparatus claims is given limited patentable weight. The Kuo device is capable of the claimed functions. The examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all claimed structural limitations and therefore anticipates the claim. See MPEP 2114.

Appellant argues "Claims 17-21 and 23 were rejected as claim 16 under 35 U.S.C. 102(e). Since claims 17-21 and 23 depend directly or indirectly from and contain

all the limitations of claim 16, they are felt to overcome the 102 rejection in the same manner as claim 16.”

In response, the rejection is maintained for the reasons outlined above.

Appellant argues “Claims 1, 2, 11-15 and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo in view of Girvin (US Patent No. 6,382,370). For the reasons stated above, Kuo fails to disclose art adjustment assembly as recited in claim 1. Therefore, the combination of Kuo and Girvin fails to disclose an adjustment assembly as recited in claim 1. For this reason, the rejection of claim 1 should be withdrawn.”

In response, the rejection is maintained for the reasons outlined above.

Appellant argues “Claims 2, 11-15 and 26 were rejected as claim 1 under 35 U.S.C. 103(a). Since claims 2, 11-15 and 26 depend directly or indirectly from and contain all the limitations of claim 1, they are felt to overcome the t03 rejection in the same manner as claim 1.”

In response, the rejection is maintained for the reasons outlined above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Terence Boes/

Examiner, Art Unit 3656

Conferees:

/MJ/ Marc Jimenez

/Vicky A. Johnson/
Primary Examiner, Art Unit 3656